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10/099,936	03/13/2002	Andrew McIntosh Soutar	23905-029	3281

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09/28/2007

EXAMINER

TALBOT, BRIAN K

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1762

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/099,936
Filing Date: March 13, 2002
Appellant(s): SOUTAR ET AL.

MAILED
SEP 28 2007
GROUP 1700

Paul Fleischut
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 2, 2007 appealing from the Office action mailed October 6, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0150692	Soutar et al.	10-2002
6,395,329	Soutar et al.	5-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 18-26 and 32-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The terms “fatty amides” and “oxidant” being part of the immersion silver plating solution are not found in the original disclosure or in the continuing applications US Application No. 08/939,656 or 08/567,885.

(10) Response to Argument

Appellant stated that the terms “fatty amides” (specification, pg. 22, line 13 – paragraph [0072] of US 2002/0150692) and “oxidant” (paragraphs [0086], [0103], [0123] and [0125]).

The Examiner disagrees with Appellant. The specification does teach “amides” or “ethoxylated amides” (pg. 22, lines 13 and 15) but no recitation that these amides are “fatty amides”. The argument that since the fatty amines are recited means that the amides would also be “fatty”, since they are derived from a product reaction between a carboxylic acid and an

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amine, is unconvincing. No supporting documentation is provided to refute the Examiner's position that the amides would indeed be "fatty".

Regarding the term "nitric acid", Appellant argues that nitric acid is a well known oxidant for copper and that the paragraphs noted above support this conclusion.

The Examiner disagrees. The paragraphs stated above do not recite that the nitric acid is an oxidant. In fact, paragraph [0086] recites nitric acid as being a buffering agent. Regarding the cited US Patents, the teaching that nitric acid can be used as an oxidant, does not provide support for the instant application. Furthermore, the addition and reasons for using nitric acid would also be dependent upon the specific type of solution utilized. As is clearly recited in the instant application, nitric acid is utilized as a buffering agent and no reference for it being an "oxidant" is found in the specification.

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(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

BK Talbot 9/26/07

Brian K. Talbot

Conferees:

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